

REMARKS

Applicants have carefully considered the August 9, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-5 are pending in this application. In response to the Office Action dated August 9, 2005, claim 1 has been amended to correct obvious typographical errors. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Office Action does not acknowledge receipt of the Information Disclosure Statement (IDS) filed February 28, 2005. Applicants attach herewith, a courtesy copy of the IDS along with the stamped acknowledgment postcard for the Examiner's consideration. It is respectfully requested that the references be expressly considered during the prosecution of this application, and that the references be made of record therein.

Claim 1 was objected to because of minor informalities. Applicants have amended claim 1 to address the Examiner's objections. Accordingly, reconsideration and withdrawal of the objection are solicited.

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harashina (U.S. Pat. No. 6,753,363, hereinafter "Harashina") in view of Hagiwara et al. (U.S. Pat. No. 3,805,985, hereinafter "Hagiwara") and Forschirm (U.S. Pat. No. 5,886,066, hereinafter

“Forschirm”). The Examiner asserted, at pages 3-4 of the Office action, that Harashina discloses a polyacetal composition of the instant claims, but for (i) the specified content of polyethylene and vinylacetate in the polyethylene vinylacetate copolymer and (ii) 0.1 to 2 parts by weight of hydroxyl pentaerythritol fatty acid ester. The Examiner concluded that at the time of the invention, it would have been obvious to a person skilled in the art modify the composition taught in Harashina by using the specific type of ethylene/vinyl acetate copolymer as disclosed by Hagiwara because the resulting product would allegedly possess anti-shock durability and thereby improve the quality of the molded article. Moreover, the Examiner relied on the additional teachings of Forschirm and concluded that it would have been obvious to a person skilled in the art modify the composition of Harashina by using the specific hydroxyl pentaerythritol fatty acid ester as disclosed by Forschirm because the ester would allegedly act as a processing aid and thereby improve the moldability of the composition into various articles. Applicants respectfully traverse the rejection.

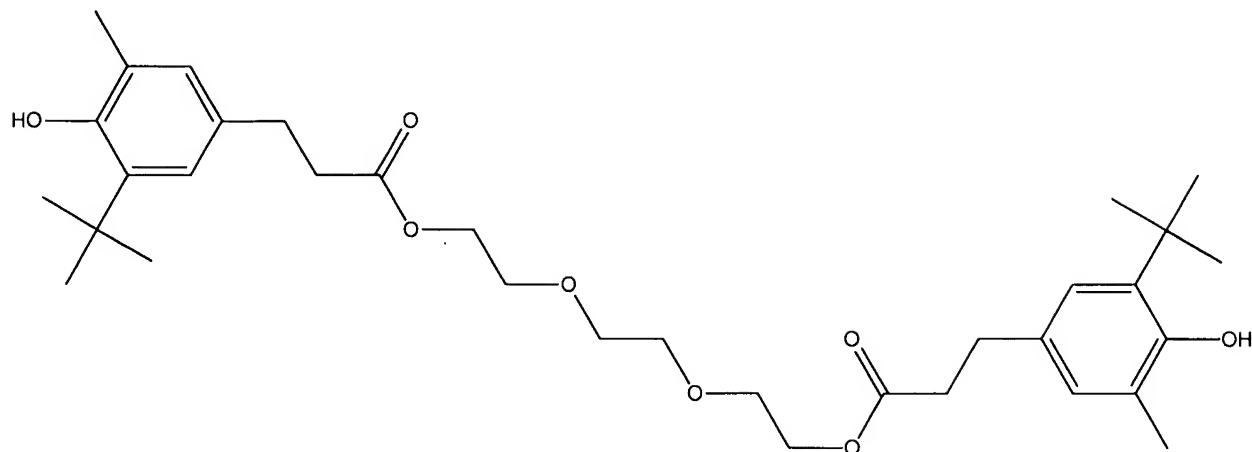
The polyacetal resin composition of the present subject matter comprises 100 pbw (part by weight) of polyoxymethylene or copolymer thereof, 0.01-1.0 pbw of antioxidant, 0.01-1.0 pbw of thermal stabilizer, 0.5-5.0 pbw of polyethylene vinylacetate copolymer of formula 3, and 0.1-2.0 pbw of hydroxyl pentaerythritol fatty acid ester of Formula 4. The object of the present invention is the improvement of wear resistance with the polyethylene vinylacetate copolymer of Formula 3 and prevention of surface abruption of article prepared from the polyacetal resin with hydroxyl pentaerythritol fatty acid ester of Formula 4.

The polyacetal resin composition of Harashina has high flame retardancy and stability and thus the intended characteristics of the composition are different than that of the present claimed subject matter. Further, Harashina discloses only polyoxymethylene resin, general

species of antioxidant and thermal stabilizer for polyoxymethylene resin and does not disclose a specific polyethylene vinylacetate for improving friction-wear resistance and a specific hydroxyl pentaerythritol fatty acid ester for preventing surface abrasion of articles prepared from the polyacetal resin. Particularly, the polyethylene vinylacetate of the present claimed subject matter is made of specific ration of polyethylene and vinylacetate considering friction-wear resistance of polyacetal resin composition and compatibility with polyacetal resin composition. These features are neither disclosed nor suggested in Harashina.

Hagiwara relates to a coated glass article having a coated layer directly adhered to a surface of the glass article, and polyethylene vinylacetate is only a component of the resin used for forming the coating layer. Therefore, disclosure of Hagiwara is different from the present claimed subject matter in terms of the technical field and features. Furthermore, the effect of the present invention, such as improvement of wear resistance and abrasion-preventing effect cannot be expected from the anti-shock durability in Hagiwara.

The Examiner states that triethyleneglycol-bis-3-(3-t-butyl-4-hydroxy-5-methylphenyl) propionate is a species of hydroxyl pentaerythritol fatty acid ester and a person skilled in this art can easily choose triethyleneglycol-bis-3-(3-t-butyl-4-hydroxy-5-methylphenyl) propionate from the disclosure of Forschirm and apply it to the composition of Harashina. However, the chemical structure of triethyleneglycol-bis-3-(3-t-butyl-4-hydroxy-5-methylphenyl) propionate in Forshirm, which is attached below is different from that of the hydroxyl pentaerythritol fatty acid ester of Formula 4 of claim 1.



triethyleneglycol-bis-3-(3-t-butyl-4-hydroxy-5-methylphenyl) propionate

Thus, triethyleneglycol-bis-3-(3-t-butyl-4-hydroxy-5-methylphenyl) propionate in Forshirm cannot be regarded as a species of the hydroxyl pentaerythritol fatty acid ester of Formula 4 of the present subject matter. Further, triethyleneglycol-bis-3-(3-t-butyl-4-hydroxy-5-methylphenyl) propionate is described as an example of antioxidant in this invention. Therefore, triethyleneglycol-bis-3-(3-t-butyl-4-hydroxy-5-methylphenyl) propionate cannot be selected to be applied to the composition of Harashina as a hydroxyl pentaerythritol fatty acid ester.

Applicants respectfully submit that in view of the foregoing, the Examiner has not established a prima facie basis to deny patentability to the claimed inventions under 35 U.S.C. § 103 for lack of the requisite factual basis and lack of the requisite realistic motivation. *Smiths Industries Medical System v. Vital Signs Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). The Examiner failed to discharge the initial burden of identifying any basis of record upon which to predicate the conclusion that one having ordinary skill in the art would have been realistically impelled to modify Harashina's composition with Hagiwara or Forschirm.

The requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 requires not only a suggestion but a reasonable expectation of success as to a

particular benefit. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present case, the Examiner has not established that the prior art teaches, with a reasonable expectation of success, that a particular benefit would result from the Examiner's proposed combination. Rather, the Examiner's conclusion is speculative and amounts to nothing more than the judicially condemned "obvious to try" standard. *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Indeed, the only place where the motivation can be found is in Applicants' own disclosure, which, of course, is forbidden territory for the Examiner to obtain the requisite motivation to combine the references. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985). None of the applied references teaches or suggest improving friction-wear resistance and preventing abruption by using specific polyethylene vinylacetate copolymer and hydroxyl pentaerythritol fatty acid ester as claimed.

Accordingly, for the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-5 under 35 U.S.C. § 103.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

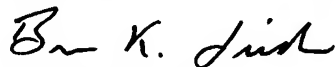
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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